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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/739,438	12/18/2003	Toby L. Burton	AUS920030592US1	9297
35525 7590 04/18/2007 IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER ANWARI, MACEEH	
			ART UNIT 2109	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			04/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/739,438

Applicant(s)

BURTON ET AL.

Examiner

Maceeh Anwari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 18 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/18/2003 *μ, A*
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is the initial Office action based on the 10/739438 application filed December 18, 2003. Claims 1-25, as originally filed, are currently pending and have been considered below.

#### ***Specification***

1. The disclosure is objected to because of the following informalities: on page 3, paragraph 34 the applicant makes a reference to another U.S. Patent application however fails to provide the corresponding application number.

Appropriate correction is required.

2. The disclosure is objected to because of the following informalities: on page 3, paragraph 36 applicant discloses "monitor specification 300" in reference to figure 3; however there is no number 300 corresponding to the statement anywhere within figure

Appropriate correction is required.

#### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: on page 3, paragraph 36 applicant references a number 300 within figure 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted

after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because in figure 5c applicant discloses within the parameters for monitor provisioning an "adminserver\_object\_level" and later refers to the same thing in the parameters for monitor de-provisioning as "adminserver\_object\_label." The "level" should be changed to "label". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claims 1-2 & 7 are rejected as falling under the judicial exception of an abstract idea which lacks a useful, concrete, and tangible result. A claimed series of steps or acts that do not result in a useful, concrete, and tangible result are not statutory within the meaning of 35 USC 101. In the instant case, the claims recite, "providing," and "associating." However, no useful, concrete, and tangible result is claimed. For example, "writing said data," "updating said data," "sending said data" being claimed at the end of the claim may comprise a useful, concrete, and tangible result. Absent such a result, however, the claims are not statutory.

Claims 12-22 are rejected under 35 U.S.C. 101 because the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "non-functional descriptive material." Both types of "descriptive material" are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claims 23-25 are rejected under 35 U.S.C. 101 because the claims fail to place the invention squarely within one statutory class of invention. On page 5, paragraph 65 of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear for one of ordinary skill in the art to determine what the applicant is claiming when referring to "monitor specifications" and "resource specifications" in relation to "parameters for a monitor" and "parameters for a resource;" while trying to define a method for "provisioning resource monitors." The applicant has further stated, along with numerous other instances throughout the claims, phrases such as "resource monitor instance configuration profile for an instance of a given resource monitor for a given resource instance," with out effectively defining the terms within the disclosure. Ultimately failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 112***

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It is unclear for one of ordinary skill in the art to determine what the applicant is claiming when referring to “monitor specifications” and “resource specifications” in relation to “parameters for a monitor” and “parameters for a resource;” while trying to define a method for “provisioning resource monitors.” The applicant has further stated, along with numerous other instances throughout the claims, phrases such as “resource monitor instance configuration profile for an instance of a given resource monitor for a given resource instance,” with out effectively defining the terms within the disclosure. Ultimately failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claim Rejections - 35 USC § 102***

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lumelsky et al. (hereinafter Lumelsky), U.S. Patent No.: 6,460,082.

Lumelsky teaches:

Claim 1:

A method for provisioning resource monitors (Col. 1, lines 10-15), the method comprising: providing at least one monitor specification, wherein a monitor specification includes a definition of parameters for a monitor (Figure 1-2 & 4 and Col. 7, lines 38-57; where the service signature reads on both the limitations of at least one monitor specification and parameters for a monitor); providing at least one resource specification, wherein a resource specification includes a definition of parameters for a resource (Figure 1-2 & 4 and Col. 7, lines 28-57; where the resource envelope reads on both the resource specification and a the parameters); and associating at least one monitor specification with a resource specification (Figure 1-2 & 4 and Col. 7, lines 38-57; associates the service signature and the resource envelope).

Claim 2:

The method of claim 1, further comprising: providing a resource monitor instance configuration profile for an instance of a given resource monitor for a given resource instance (Figures 1-2 & 4; all show configurations, for instances, of internal and external views of meta-resource, resource envelopes, service management metadata and resource management metadata).

Claim 3:

The method of claim 2, further comprising: receiving a selection of a given monitor to be provisioned for the instance of the given resource (Figure 1 shows that there are a plurality of resources and metadata to monitor them with); and storing a monitor configuration profile for the given monitor in association with the resource instance configuration profile (Figures 2 & 4 reads of the limitation of storing instances of monitors, with storage bins and global pools, and memory slots).

Claim 4:

The method of claim 3, further comprising: receiving at least one value for a parameter for the given monitor, wherein the monitor configuration profile includes the at least one value for a parameter (Figure 2 gives one value for the parameter of cost and uses it within the service signature).

Claim 5:

The method of claim 4, wherein receiving at least one value for a parameter for the given monitor includes presenting an interface to define parameters for the given monitor based on a monitor specification for the monitor (Figure 7 reads on the limitation of providing an interface with the Native Resource Management Interface; and Col. 13, lines 32-65; refers to numerous

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interfaces like the service unit mapper module where parameters are exchanged, defined and utilized).

Claim 6:

The method of claim 3, further comprising: deploying the monitor in accordance with the monitor configuration profile (Figure 2 shows the service unit configuration and it's deployment, of the monitor, in accordance to the specified profile).

Claim 7:

The method of claim 6, wherein deploying the monitor further includes: determining whether manual intervention is required for the monitor (Figure 8a and Col. 15, lines 12-64; reads on the manual intervention requirement because it shows the process for handling a provisioning request, and how it is ultimately determined by the client); and responsive to manual intervention being required for the monitor, interacting with an administrator to receive at least one value for a parameter (Figures 8a and Col. 15, lines 40-46; reads on interacting with an administrator/server).

Claim 8:

The method of claim 3, further comprising: storing response parameters and values in a response profile (Figures 1-8a; reads on the limitation of storing

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response parameter and values, because it shows how the specified parameters/values are stored and utilized throughout i.e. figure 2 with the cost value).

Claim 9:

The method of claim 8, further comprising: deprovisioning the monitor using the response parameters and values in the response profile (This is an inherent feature that the parameters used to identify, and ultimately create, a monitor would be used to identify and remove the monitor).

Claim 10:

The method of claim 3, further comprising: capturing output parameters and values of a monitor deployment and storing them to the response profile (Figures 1-8a, read on the limitation of storing of parameters and values through metadata and the service signature).

Claim 11:

The method of claim 2, wherein the resource instance is a resource of a type selected from the group consisting of server hardware, network hardware, storage hardware, operating system software, database middleware software, application software, and monitoring software (Figures 1-2 & 7).

Claim 12:

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An apparatus for provisioning resource monitors (Col. 1, lines 10-15), the apparatus comprising: means for providing at least one monitor specification, wherein a monitor specification includes a definition of parameters for a monitor (Figure 1-2 & 4 and Col. 7, lines 38-57; where the service signature reads on both the limitations of at least one monitor specification and parameters for a monitor); means for providing at least one resource specification, wherein a resource specification includes a definition of parameters for a resource (Figure 1-2 & 4 and Col. 7, lines 28-57; where the resource envelope reads on both the resource specification and a the parameters); and means for associating at least one monitor specification with a resource specification (Figure 1-2 & 4 and Col. 7, lines 38-57; associates the service signature and the resource envelope).

## Claim 13.

The apparatus of claim 12, further comprising: means for providing a resource instance configuration profile for an instance of a given resource monitor for a given resource (Figures 1-2 & 4; all show configurations, for instances, of internal and external views of meta-resource, resource envelopes, service management metadata and resource management metadata).

## Claim 14:

The apparatus of claim 13, further comprising: means for receiving a selection of a given monitor to be provisioned for the instance of the given

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resource (Figure 1 shows that there are a plurality of resources and metadata to monitor them with); and means for storing a monitor configuration profile for the given monitor in association with the resource instance configuration profile (Figures 2 & 4 reads of the limitation of storing instances of monitors, with storage bins and global pools, and memory slots).

**Claim 15:**

The apparatus of claim 14, further comprising: means for receiving at least one value for a parameter for the given monitor, wherein the monitor configuration profile includes the at least one value for a parameter (Figure 2 gives one value for the parameter of cost and uses it within the service signature).

**Claim 16:**

The apparatus of claim 15, wherein the means for receiving at least one value for a parameter for the given monitor includes means for presenting an interface to define parameters for the given monitor based on a monitor specification for the monitor (Figure 7 reads on the limitation of providing an interface with the Native Resource Management Interface; and Col. 13, lines 32-65; refers to numerous interfaces like the service unit mapper module where parameters are exchanged, defined and utilized).

Claim 17:

The apparatus of claim 14, further comprising: means for deploying the monitor in accordance with the monitor configuration profile (Figure 2 shows the service unit configuration and its deployment, of the monitor, in accordance to the specified profile).

Claim 18:

The apparatus of claim 17, wherein deploying the monitor further includes: means for determining whether manual intervention is required for the monitor (Figure 8a and Col. 15, lines 12-64; reads on the manual intervention requirement because it shows the process for handling a provisioning request, and how it is ultimately determined by the client); and means, responsive to manual intervention being required for the monitor, for interacting with an administrator to receive at least one value for a parameter (Figures 8a and Col. 15, lines 40-46; reads on interacting with an administrator/server).

Claim 19:

The apparatus of claim 14, further comprising: means for storing response parameters and values in a response profile (Figures 1-8a; reads on the limitation of storing response parameter and values, because it shows how the

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specified parameters/values are stored and utilized throughout i.e. figure 2 with the cost value).

Claim 20:

The apparatus of claim 19, further comprising: means for deprovisioning the monitor using the response parameters and values in the response profile (This is an inherent feature that the parameters used to identify, and ultimately create, a monitor would be used to identify and remove the monitor).

Claim 21:

The apparatus of claim 14, further comprising: means for capturing output parameters in a deployment output configuration profile Figures 1-8a, read on the limitation of storing of parameters and values through metadata and the service signature).

Claim 22:

The apparatus of claim 13, wherein the resource instance is a resource of a type selected from the group consisting of server hardware, network hardware, storage hardware, operating system software, database middleware software, application software, and monitoring software (Figures 1-2 & 7).

Claim 23:

A computer program product, in a computer readable medium, for provisioning resource monitors (Col. 1, lines 10-15), the computer program product comprising: instructions for providing at least one monitor specification, wherein a monitor specification includes a definition of parameters for a monitor (Figure 1-2 & 4 and Col. 7, lines 38-57; where the service signature reads on both the limitations of at least one monitor specification and parameters for a monitor); instructions for providing at least one resource specification, wherein a resource specification includes a definition of parameters for a resource (Figure 1-2 & 4 and Col. 7, lines 28-57; where the resource envelope reads on both the resource specification and a the parameters); and instructions for associating at least one monitor specification with a resource specification (Figure 1-2 & 4 and Col. 7, lines 38-57; associates the service signature and the resource envelope).

Claim 24:

The computer program product of claim 23, further comprising:  
instructions for providing a resource instance configuration profile for an instance of a given resource monitor for a given resource (Figures 1-2 & 4; all show configurations, for instances, of internal and external views of meta-resource, resource envelopes, service management metadata and resource management metadata).

Claim 25:

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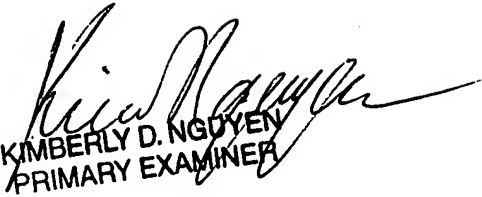
The computer program product of claim 24, further comprising:  
instructions for receiving a selection of a given monitor to be provisioned for the instance of the given resource (Figure 1 shows that there are a plurality of resources and metadata to monitor them with); and instructions for storing a monitor configuration profile for the given monitor in association with the resource instance configuration profile (Figures 2 & 4 reads of the limitation of storing instances of monitors, with storage bins and global pools, and memory slots).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maceeh Anwari whose telephone number is 571-272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Del Sole can be reached on 571-272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.

  
KIMBERLY D. NGUYEN  
PRIMARY EXAMINER